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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838

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EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

10

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/408,265

Applicant(s)

KIMURA, ETSUKO

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/23/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. US Patent No. 5,956,655.

1.1 Regarding claim 1, Suzuki discloses a portable communication device in figures 2-4, comprising:

a plurality of soft keys 1A-1D associated one-to-one with a plurality of guide areas of display 2 (column 4, lines 50-63).

Examiner interprets the claim language of lines 5-8 as follows:

control means for displaying operation items. The operation items are displayed in the guide areas, and when one of the operation items is selected by pressing one of said plurality of soft keys corresponds to the guide areas, a subset of operation items are displayed. Suzuki teaches that in figure 4A, items "MEMORY CALL", "AUX FUNCTION" and "REDIAL" corresponds to soft keys 1A, 1C and 1D are displayed. When item "MEMORY" is selected, figure 4B is displayed and items "CALL", "SCROLL UP", "RETURN", and "SCROLL DOWN" are displayed in the guide areas. When item "CALL" is selected next, figure 4C is displayed and items "HOLD", "RECEIVING VOLUME" and "END" are displayed in the guide areas (column 5, lines 51-65; column 6, lines 12-17; column 8, lines 28-39).

Suzuki teaches selected items are displayed hierarchically, because "items displayed hierarchically" refers to as "display items [function] in order according to the hierarchy level of input command" (column 6, lines 51-55).

Suzuki further teaches that the names of items [functions] assigned to the soft keys at each hierarchy level can be displayed on the display unit 2 (column 6, lines 55-58).

1.2 Regarding claim 3, Suzuki discloses a portable communication device in figures 2, 3, 4 and 27, comprising:

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storing means [memory 1219] for storing a plurality of functions which can be selected by a user (column 2, lines 43-45; column 6, lines 51-58);

a display 2 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 4, lines 50-63);

a key input section a plurality of soft keys 1A-1D associated one-to-one with a plurality of guide areas (column 2, lines 25-27, 34-39).

Examiner interprets the claim language of lines 8-12 as follows:

control means for displaying operation items. The operation items are displayed in the guide areas, and when one of the operation items is selected by pressing one of said plurality of soft keys corresponds to the guide areas, a subset of operation items are displayed. Suzuki teaches that in figure 4A, items "MEMORY CALL", "AUX FUNCTION" and "REDIAL" corresponds to soft keys 1A, 1C and 1D are displayed. When item "MEMORY" is selected, figure 4B is displayed and items "CALL", "SCROLL UP", "RETURN", and "SCROLL DOWN" are displayed in the guide areas. When item "CALL" is selected next, figure 4C is displayed and items "HOLD", "RECEIVING VOLUME" and "END" are displayed in the guide areas (column 5, lines 51-65; column 6, lines 12-17; column 8, lines 28-39).

Suzuki teaches selected items are displayed hierarchically, because "displayed hierarchically" refers to as "displayed in order according to the hierarchy level of input command" (column 6, lines 51-55).

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Suzuki further teaches that the names of items [functions] assigned to the soft keys at each hierarchy level can be displayed on the display unit 2 (column 6, lines 55-58).

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Schroeder et al. US Patent No. 5,797,098.

2.1 Regarding claim 1, Schroeder discloses a portable communication device in figures 1A and 1B, comprising:

a plurality of soft keys 9 associated one-to-one with a plurality of guide areas of display 11 (Figure 1A; column 3, lines 27-33);

control means [Figure 1B, CONTROLLER 23] for processing selected items in the guide areas when one of said plurality of soft keys next to the guide areas is pressed [As an example, in figure 11A, items "MUTE" and "SCRATCHPAD" corresponds to left and right soft keys 9 are displayed. When item "SCRATCHPAD" is selected by pressing the right soft key 9, figure 11B is displayed and items "MUTE", "CANCEL" and "SAVE" are displayed in the guide areas, and item CRATCHPAD is displayed in the display area 11] (column 10, lines 21-26, 34-39); and

selected items are therefore displayed hierarchically.

2.2 Regarding claim 3, Schroeder discloses a portable communication device in figures 1A and 1B, comprising:

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storing means [ROM 22] for storing a plurality of functions which can be selected by a user;

a display 11 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (Figure 1A; column 3, lines 27-33);

a key input section a plurality of soft keys 9 associated one-to-one with a plurality of guide areas (column 3, lines 2-33);

control means [CONTROLLER 23] for processing selected items in the guide area when one of said plurality of soft keys is pressed [As an example, in figure 11A, items "MUTE" and "SCRATCHPAD" corresponds to left and right soft keys 9 are displayed. When item "SCRATCHPAD" is selected by pressing the right soft key 9, figure 11B is displayed and items "MUTE", "CANCEL" and "SAVE" are displayed in the guide areas, and item CRATCHPAD is displayed in the display area 11] (column 10, lines 21-26, 34-39); and

selected items are therefore displayed hierarchically (column 6, lines 51-58).

3. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. US Patent No. 5,737,394.

3.1 Regarding claim 1, Anderson discloses a portable electronic device in figures 2-10, comprising:

a plurality of soft keys 20 associated one-to-one with a plurality of guide areas 64, included in a display area 8 (figure 4; column 4, lines 3-8);

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 5, lines 39-49); and

selected functions are displayed hierarchically, such as in figure 9A, when item "MSG" is selected in S500, items "VM", "NEW" and "OUT" are displayed in S510. When "VM" is selected next, items "DEL", "ANSW" and "OUT" are displayed in S550 (column 14, lines 56-63).

3.2 Regarding claim 3, Anderson discloses a portable electronic device in figures 2-10, comprising:

storing means [memory 52, figure 3] for storing a plurality of functions which can be selected by a user (column 7, lines 17-35);

a display 18 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 5, lines 18-21, 50-64);

a key input section a plurality of soft keys 20 associated one-to-one with a plurality of guide areas 64 included in a display area 18 (column 4, lines 3-8; column 5, lines 18-21);

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 5, lines 39-64; column 11, lines 32-39; column 12, lines 8-19); and



selected functions are displayed hierarchically, such as in figure 9A, when item "MSG" is selected in S500, items "VM", "NEW" and "OUT" are displayed in S510. When "VM" is selected next, items "DEL", "ANSW" and "OUT" are displayed in S550 (column 14, lines 56-63).

3.3 regarding claim 4, Anderson discloses that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display, said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figure 2B; figure 4; column 4, lines 3-8).

3.4 Regarding claim 5, Anderson discloses that the guide areas comprise character sequence representative of the operation items which can be selected by the user (column 5, lines 18-21; column 7, lines 32-39; column 12, lines 8-19).

3.5 Regarding claim 7, Anderson discloses that the guidance information comprises marks appearing on another display line of said display areas for designating values of set statuses in a form of the operation items which can be selected by the user (column 12, lines 8-19).

3.6 Regarding claims 2, 6 and 8-10, Anderson's device is a portable telephone (figure 2; column 3, lines 52-58).

***Response to Arguments***

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4. Applicant's arguments filed on 01-23-2003 have been fully considered but they are not persuasive.

The applicant amended claims 1 and 3 by adding: "selected items are displayed hierarchically".

The applicant argues "items selected are displayed hierarchically" means that a previous display stays-on from one step to next, such as in figure 9, the display "KEY TONE" stays-on from step II to step III when items "ON" or "OFF" is selected (Suzuki teaches this limitation in column 6, lines 55-58). The examiner disagrees with this argument. Displayed hierarchically means functions [items] are displayed in order, such as from a parent function to its child functions. Once in a child function, it can only go to another lower order child-child function, or back to its parent function, but cannot jump to other parent functions (out of hierarchical order). As an example, in figure 9A of the Anderson reference, once in step S510 (item MSG selected from step S500), a user can only select lower order functions [or items] "VM" and "NEW", or "OUT" to go back to its parent function in S500, but cannot select "MENU" (in S500) from S510. Therefore, references of Suzuki, Schroeder and Anderson read on claims 1 and 3.

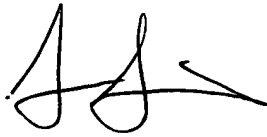
### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



S.S.

04/04/2003

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